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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/687,766

10/20/2003

Johannes A. Pardoen

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11/15/2006

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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/687,766	Applicant(s) PARDOEN ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 8/24/06.

The new grounds of rejection set forth below are necessitated by applicants' amendment and thus, the following action is final.

Priority

2. As set forth in paragraph 1 of the office action mailed 3/24/06, while acknowledgment is made of applicant's claim for foreign priority based on an application filed in Europe on 10/29/02, it is noted, however, that applicant has not filed a certified copy of the application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The last two lines of newly added claim 19 recite that the intermediate, which is formed by reacting polyamine derived compound with at least one amine specific reagent and optionally with an amine modifier, has an anchoring moiety with affinity for a pigment surface or substrate

and a stabilizing moiety with an affinity for a matrix. However, the scope of the claim is confusing given that the use of the amine modifier which contains the anchoring moiety and stabilizing moiety is optional, i.e. may or may not be present, and thus, it is not clear how, if the amine modifier is not present, the intermediate would have an anchoring moiety with affinity for a pigment surface or substrate and a stabilizing moiety with an affinity for a matrix. That is, it would appear that in order for the intermediate to have the anchoring moiety and the stabilizing moiety as presently claimed, the amine modifier would necessarily have to be required and not optional. Should “optionally” be removed from line 12 of claim 19? Clarification is requested.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-7, 9-10 and 13-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Schipfer et al. (U.S. 4,563,515).

The rejection is adequately set forth in paragraph 5 of the office action mailed 3/24/06 and is incorporated here by reference.

Response to Arguments

7. Applicants' arguments regarding Jacobs, III et al. (U.S. 4,897,435), Honel et al. (U.S. 5,055,542), Engel et al. (U.S. 4,758,615), and Honig et al. (U.S. 5,369,190) have been fully

considered but they are moot in view of the discontinuation of the use of these references against the present claims.

8. Applicants' arguments filed 8/24/06 have been fully considered but, with the exception of arguments relating to Jacobs, III et al., Honel et al., Engel et al., and Honig et al., they are not persuasive.

Specifically, applicants argue that Schipfer et al. is not a relevant reference against the present claims given that there is no disclosure in Schipfer et al. of amine modifier (formula III) as now required all the present claims.

However, attention is drawn to col.3, line 66-col.4, line 1 and col.4, lines 6-8 of Schipfer et al. which disclose the use of amine modifier, namely, N, N-dimethylpropanediamine-1,3 which is identical to amine modifier utilized in the present invention and is noted, corresponds, to presently claimed formula III when $y = z = 0$ and Y is anchoring moiety, i.e. tertiary amine comprising five carbon atoms, identical to the anchoring moiety of the present invention. In light of this disclosure, it is not clear why applicants' argue that there is no disclosure of amine modifier in Schipfer et al. Clarification is requested.

With respect to present claim 9, applicants argue that given that Schipfer et al. do not disclose a formula for the polyamine derivative produced, Schipfer et al. cannot anticipate the claim given that the claim is not a method claim or product-by-process claim but requires polyamine derivative of specific formula.

However, although Schipfer et al. do not disclose a formula for the disclosed polyamine, given that the polyamine is produced by reacting polyamine having primary and secondary amino groups with hydroxycarboxylic acid or lactone to form product, i.e. polyamine derived compound, which is then reacted with epoxy resin having at least two functional epoxy groups, i.e. amine specific reagent, and N,N-dimethylpropanediamine-1,3, i.e. amine modifier, which is identical to the how the polyamine derivative of the present invention is produced, it is the examiner's position, absent evidence to the contrary, that Schipfer et al. do disclose polyamine derivative as required in present claim 9.

Applicants argue that the fact that Schipfer et al. disclose process recited in some other claim whether true or not has no relevance to present claim 9.

However, the fact that Schipfer et al. do not explicitly disclose the formula of the polyamine does not mean that the polyamine does not meet the requirements of present claim 9. In the absence of an explicitly recite formula, it would appear that a proper way to determine whether Schipfer et al. meets the requirements of present claim 9 would be how the polyamine of Schipfer et al. is produced. If the polyamine were produced using same method and components as is the polyamine of the present invention, it would necessarily follow that the polyamine would be the same as that required in present claim 9. Given that the polyamine of Schipfer et al. is produced by same method as polyamine of the present invention, it is the examiner's position that the polyamine of Schipfer et al. would necessarily inherently be the same as the polyamine required in present claim 9.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

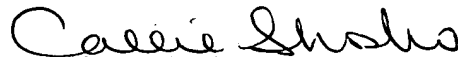
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
11/11/06